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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,151	10/16/2003	Michael L. White	BE1-0038US	8229

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EXAMINER
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TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/687,151

Applicant(s)

WHITE ET AL.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/13/04, 11/26/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features:

the recitation "the force applied from the piston for driving the support device into a pole is variable" in claim 11;

the recitation "further comprising an extension pole for attaching to the housing" in claim 12; and

the recitation "further comprising an extension pole for elevating the powder driven tool" in claim 20;

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the preamble of claim 1, "a powder driven tool" is claimed, and yet the subsequence dependent claims (of claim 1), the details of other features such as the guide member, the fastener (i.e. support device), and the material of the fastener, etc. are also claimed as part of the powder tool. It is confusing and unclear what is the claimed invention. If the powder tool is the claimed invention, then the structure of the other such as the fastener is not germane to the scope of the invention, unless the guide member and the fastener are being claimed in combination with the powder tool.

Thus, it is suggested that the Applicant to amend the claims to eliminate the indefiniteness as discussed above.

Similarly, the independent claims 13 and 15 are indefinite for the same reason that the examiner has pointed out above.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 5, 10, 11, and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Osterle (4,068,790).

Osterle discloses an apparatus comprising:

a housing (1) including a powder cartridge (8) and piston (7) within a barrel (3);  
and

a guide member (6) attached to the barrel and cradling a support device (9), the guide member including a wall portion having a thickness greater than other portions of the guide member (the distal end of guide member 6 where it contacts the working surface 11) ,

wherein ignition of the powder cartridge causes the piston to move within the barrel and drive the support device, and the wall portion resists barrel climb as the support device is driven into an object (as in claims 1 and 13),

Wherein the guide member includes a slot for engaging the support device so that the support device is driven in a straight direction (the guide member 6 comprises a slot or bore in the middle to accommodate the piston 7 and drives the support device 9 in a straight direction toward the work piece 11) (as in claim 15, 14 and 2).

Osterle further discloses: wherein the guide member and barrel are connected by at least one of threads and a screw (5) – the distal end of the guide member (6) is threaded and connected to the barrel (3) in a screw manner (as in claim 5); wherein the piston is molded to conform to shape of the support device (as in claim 10); and wherein the force applied from the piston for driving the support device into a work piece is variable (column 1, lines 24-35 and column 6, lines 15-19) (as in claim 11).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterle (4,068,790) in view of Losada (5,417,534).

As discussed above in paragraph 5 of this office action, Osterle discloses the claimed invention, but does not expressly disclose that the support device comprises a removable guide clip for engaging the slot, however, one skill in the art would clearly recognize that the support device (9) in figure 1 has a removable guide clip at near the distal end portion, and this guide clip, in the form of a ring, engaging the slot or bore of the guide member (6) to keep the support device moving in a straight direction. To further supporting this point, the applicant's attention is drawn to the reference of Losada (5,417,534).

Losada discloses (figure 1) that a support device (18) having a removable guide clip (74) which "is used merely to guide the fastener assembly within the barrel of a power actuated gun" (column 3, lines 60-62).

8. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterle (4,068,790) in view of Anderson (2,307,348).

As discussed above in paragraph 5 of this office action, Osterle discloses the claimed invention, but did not expressly disclose that the guide member includes a gaff.

Anderson discloses the using of the gaff (8) on a device (3) so that the cap (7) will be held in place on the working surface (1). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Osterle's apparatus by incorporating the using of the gaff as taught by Anderson on the guide member to provide a better contact between the guide member and the working surfaces.

9. Claims 6-9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterle (4,068,790) in view of Van Allman et al. (4,979,858).

As discussed above in paragraph 5 of this office action, Osterle discloses the claimed invention, but did not expressly disclose the support device as recited in claim 6.

Van Allman discloses a support device 30 comprises: first end and second end, the threads (36) disposed at the first end of the shaft for use in securing the device (with

Art Unit: 3721

part 98) to a work piece (90, 92); and at least one rigid support member disposed on the second end (32) of the shaft (the second end is rigid support member because it is driven into a hard surface). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Osterle's apparatus by incorporating the support member as taught by Van Allman for providing a means to securing the working surfaces together at the end of the support member (figure 18).

Van Allman further discloses a removable guide clip (10) positioned distally of the threads on the shaft (figure 15), and the rigid support member comprises a curved portion (the taper portion between the threaded portion and the unthreaded portion is clearly a curved portion – figure 18).

Regarding claim 7, either Osterle or Van Allman expressly disclose that the support device is stainless steel or titanium. The examiner takes Official Notice that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the material such stainless steel or titanium for making the support member to produce a strong support member, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

10. Claims 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterle (4,068,790) in view of Conrad (4,479,599).



As discussed above in paragraph 5 of this office action, Osterle discloses the claimed invention, but did not expressly disclose an extension pole for attaching to the housing for elevating the powder driven tool.

Conrad discloses an apparatus comprising an extension pole (12) for attaching to the housing for elevating the powder driven tool (16) providing a means to place the tool against the ceiling by an operator (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Osterle's apparatus by incorporating the extension pole as taught by Conrad to provide a means to extend the tool in higher places.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt  
June 16, 2005.

  
Stephen F. Gerrity  
Primary Examiner

571 - 272 - 4460